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Docket No. GRTSTF.011A

CUSTOMER NUMBER 20995

Date: September 27, 2004

Page 1

In re application of : Weatherill et al.
Appl. No. : 09/777,420
Filed : February 6, 2001
For : REEL HOUSING WITH
DECORATIVE ACCESS PANEL
Examiner : Nguyen, John Quoc
Art Unit : 3654

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450, on

September 27, 2004

(Date)

Sanjivpal S. Gill
Sanjivpal S. Gill, Reg. No. 42,578

Mail Stop Appeal Brief-Patents
U.S. PATENT AND TRADEMARK OFFICE
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith are the following:

- (X) Reply Brief to the Board of Patent Appeals in 5 pages (in triplicate).
- (X) Appellants hereby request an oral hearing. The fee set forth in 37 C.F.R. 1.17(d) is enclosed.
- (X) A check in the amount of \$145 to cover the foregoing fees is enclosed.
- (X) Please charge any additional fees or credit overpayment to Deposit Account No. 11-1410.
- (X) Return prepaid postcard.

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GRTSTF.011A

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Weatherill et al.
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CERTIFICATE OF MAILING

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Sanjiv S. Gill
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ON APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES
APPELLANTS' REPLY BRIEF

Mail Stop Appeal Brief -- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is filed in response to the Examiner's Answer in this appeal, mailed on July 26, 2004.

I. Examiner Has Not Established *Prima Facie* Case of Obviousness

The Examiner continues to reject Claims 1-23, 25, and 28 under 35 U.S.C. §103(a) as being unpatentable over Hall, U.S. Patent No. 2,403,277. The Examiner also continues to reject Claim 27 under 35 U.S.C. §103(a) as being unpatentable over Hall in view of Ewald, U.S. Patent No. 2,286,904.

Appellants respectfully submit that when a rejection for obviousness depends on a combination of elements disclosed in prior art references, there must be a suggestion or motivation to combine those particular elements in the prior art **as a whole**. Although a prior art device may be capable of being modified to achieve the claimed structure, there must be a suggestion or motivation in the reference for doing so. *In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990). The Examiner's asserted combination fails to provide a *prima facie* case of

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obviousness as the Examiner has not shown any teaching or suggestion in the cited references to combine the individual elements in the manner claimed in the present invention.

The Examiner has based the obviousness rejection of Claims 1-23, 25, and 28 on a single reference, Hall. When an obviousness rejection is based on a single reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *See In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). Such suggestion or motivation may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved. *Id.* Such suggestion or motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Broad conclusory statements standing alone are not evidence. *Id.*

In *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999), the Federal Circuit reversed the Board of Patent Appeals and interferences' obviousness rejection of claims reciting a generally round, orange, plastic trash bag decorated with a jack-o-lantern face. The Court found that the Examiner failed to provide a **clear and particular showing** of a suggestion or motivation to combine conventional trash bags with a reference showing a jack-o-lantern face on an orange paper bag stuffed with newspapers. *Id.* (emphasis added).

The pending claims recite a reel housing configured to enclose a rotatable reel drum, the housing having an access panel having facial indicia to resemble one of an animal, human, a human-like character, and an alien creature. The claimed reel housing combines functional components of the reel with an improved aesthetic appearance. The pending claims recite **both functional and aesthetic features**, such as the location of facial indicia with respect to a functional access panel and a functional aperture within the facial indicia. Appellants respectfully submit that the Examiner has not provided a clear and particular showing of a motivation to combine the device of Hall and/or Ewald with facial indicia, whether functional or otherwise.

A. Not Obvious to Provide Facial Indicia

Neither Hall nor Ewald discloses or teaches or discloses anything about facial indicia. The Examiner states that "Hall discloses substantially all the claimed features including a housing 1, a rotatable reel for hose 31, and an access panel 2 with an aperture 17 for the hose to pass through." Examiner's Answer, at page 3, lines 10-12. The Examiner notes that Hall does

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not disclose any facial indicia and that “the facial indicia is considered an ornamental feature because it does not affect the way the apparatus of Hall works or how it is used.” *See id.* at page 4, lines 10-13. Appellants disagree with the Examiner’s statement contending “[t]hat the exterior surface of the access panel has a facial indicia to resemble one of an animal, human-like character, or alien creature (as recited in claims 1, 4-7, 9-19, 21, and 25) would have been an obvious matter of ornamental design choice to a person having ordinary skill in the art based on ornamental preference, providing no new or unexpected results.” *Id.* at page 3, lines 12-16.

The Examiner contends that Appellants have not provided any argument that the facial indicia are “significant to the operation of the apparatus or to the way it is used or is anything more than one of numerous ornamental designs a person of ordinary skill in the art could choose as an obvious matter of ornamental design.” *Id.* at page 5, lines 1-5. The Examiner also suggests that the claimed invention be filed as a Design application rather than a Utility application. *See Id.* at page 5, lines 6-8. However, the claims are rejected on obviousness grounds and not on lack of utility.

If the claims were rejected for lack of utility, this Reply Brief would focus on case law on the utility requirement, such as *Juicy Whip, Inc. v. Orange Bang, Inc.*, 185 F.3d 1364 (Fed. Cir. 1999). This Reply Brief is, however, focused on rejection based on obviousness. In *Juicy Whip*, the Federal Circuit found utility in a post-mix beverage dispenser having a transparent bowl filled with a fluid that simulates the appearance of a pre-mix dispenser. The court reasoned that the *appearance* of mixing the drink on the spot was “in itself a specific benefit sufficient to satisfy the statutory requirement of utility.” *Id.* at 1367. In other words, the court found utility in claim elements that related only to aesthetic aspects of the claimed device.

Notwithstanding the Examiner’s opinion that the claimed facial indicia are obvious as an ornamental design, the Examiner must set forth a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness over Hall, the Examiner must provide a suggestion or motivation in the prior art for modifying Hall to have facial indicia, as claimed. However, the Examiner has not shown any suggestion or motivation in the prior art to provide facial indicia on the apparatus of Hall, much less any suggestion or motivation to provide an aperture in the facial indicia, for the linear material. Neither Hall nor Ewald teaches or suggests, nor do they provide any motivation for, a reel housing having any kind of facial indicia.

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Furthermore, Appellants respectfully submit that little effort has been devoted to improving the aesthetic appearance of reel housings. Appellants have provided a linear material reel having, *inter alia*, a housing with facial indicia that incorporate functional components of the reel, to improve the aesthetic appearance of the housing. The Examiner has not indicated that providing such facial indicia flows naturally from the nature of the problem to be solved (improving the aesthetic appearance of a reel). The desire to improve the aesthetic appearance of a reel would not naturally lead to the use of facial indicia, much less facial indicia with the recited aperture for the linear material.

B. Broad Conclusory Statements Insufficient to Establish Obviousness

Rather than providing an explicit or implicit suggestion or motivation in the prior art to modify Hall or Ewald to include facial indicia, as required for a *prima facie* case of obviousness, the Examiner has merely made a broad conclusory statement that providing a reel housing with the claimed facial indicia would have been an obvious matter of ornamental design choice, providing no new or unexpected results.

In *In re Dembiczak*, the Federal Circuit found that the Board of Patent Appeals and Interferences “simply stated that ‘the [prior art] references would have suggested the application of . . . facial indicia to the prior art plastic trash bags.’” *In re Dembiczak*, 50 U.S.P.Q. 2d at 1617-18. The Federal Circuit rejected the Board’s conclusion that “the substitution of orange plastic for the crepe paper of [a first prior art reference] and the paper bags of [a second prior art reference] would be an obvious design choice” because the court did not “discern any finding by the Board that there was a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims.” *Id.* at 1618. As noted above, broad conclusory statements standing alone are not evidence of an explicit or implicit suggestion or motivation in the prior art to modify a prior art device to achieve the claimed structure.

II. Conclusion

In view of the foregoing arguments, Appellants respectfully submit that the rejection of the pending claims over Hall or Hall in view of Ewald are improper and should be withdrawn, and that the pending claims are allowable over the prior art of record.

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III. Request for Oral Hearing

Pursuant to 37 C.F.R. §1.194, Appellants respectfully request an Oral Hearing in this Appeal. This Request is also made in a separate paper filed herewith, and is accompanied by the fee set forth in 37 C.F.R. §1.17(d).

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: September 27, 2004

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